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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,059

Applicant(s)

QUELLAIS ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Election/Restrictions

1. In view of applicants' arguments the prior election requirement has been withdrawn and a complete and detailed office action on all species and claims as requested follows.

Reissue Applications

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claims 28, 29, and 32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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In an amendment originally filed on 9/2/94 and entered after being refiled on 10/6/94 applicant amended the independent claim which ultimately became patented claim 1 by the addition of the phrase "extending over an entire surface of said ground contact layer". Claims 28 and 32 broadens this phrase to "substantially an entire surface" and claim 29 changes this phrase (resulting in deleting this phrase and replacing it with a broader phrase) to "at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe". The elimination of the limitation of "over the entire surface" results in recapture since this limitations was added to overcome a rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The intermediate layer extending substantially over the entire sole area is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim recites the function of the intermediate layer "providing both for the distribution of shockwaves and stresses sensed by the ground contacting layer and for their diffusion over said comfort layer". In order for this function to occur, the intermediate layer must extend over a substantial surface of the sole, not merely just over the lateral heel portion. Also, the specification does not provide basis

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for an intermediate layer located on the "lateral heel" which would function as claimed and therefore the specification is not enabling for the claimed subject matter.

4. Claims 17-20, 24, and 30-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no basis in the specification for a shoe sole having a comfort layer and an intermediate layer constituted by a succession of rigid inserts. The specification clearly recited that "in the embodiment shown in FIGS. 7 and 8 (in which the comfort layer is omitted)" and the figures clearly show an embodiment with no comfort layer. The embodiments shown in figures 9-11 also do not show a comfort layer and the description of these embodiments does not refer to any comfort layer in these embodiments. The embodiment shown in figures 15 and 16 shows and describes the comfort layer as being "constituted by raised projections 8B made from the material on the upper portion 7a of the contact layer 7" and "a triple-layer sole according to the invention using two materials only, the flexibility of the comfort layer 8A to be obtained being a function of the density and/or the geometry of the points which constitute it." (column 5 lines 53-55 and column 5 line 67- column 6 line 3). The specification does recite the phrase "clear by an amount equal to the thickness of the comfort layer to be produced" is confusing, vague, indefinite, and unclear, since no comfort layer other than that formed by the points 8A is shown or described in reference to this embodiment. Reference to "the thickness of the comfort layer to be produced" is clearly undefined, unshown, and non-enabling.

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The embodiment shown in figure 11 is not clear, the specification states that "the stops 12, 13, are also formed from the contact layer 7, but it is these stops which have recesses 12a, 13a, respectively, to allow passage of the rib layer 9c, which thus comprises no recess." (column 5 lines 43-46). In figure 11 the "stops" (12 and 13) are shown as separate distinct elements not formed from the contact layer. It is not clear what elements are disclosed, how these elements are combined, i.e. the specification is not enabling.

5. Claims 14-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17 the phrase "said rigid intermediate layer.....a succession of rigid inserts...", in claim 19 the phrase "...two arc-shaped recesses...", in claim 24 the phrase "which pass through said intermediate layer, or rib...." contradict the limitation of "said intermediate layer extending over an entire surface of said ground contacting layer" as claimed in claim 1 from which these claims depend rendering the claims confusing, vague, and indefinite.

In claims 14, 17, 19, and 24-27 the phrase "said intermediate layer, or rib" lacks antecedent basis rendering the claim vague and indefinite. No "rib" has been previously recited.

Claim 20 is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. For example, what element is and/or what elements are intended to be encompassed by phrases such as

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“the latter”, “the plane of the rib”, and/or “an attachment designed for installation of ices studs”.

In claim 21 the phrase “a balanced heel piece” is confusing, and not understood. Also the phrase “and replacing the outer heel-piece of said shoe” appears to remove a previously claimed and recited element. This language is confusing, vague, and indefinite.

In claim 22 the phrases “a principal mechanical ground-gripping zone”, “ a secondary position-maintenance or gripping zone” and “neutral central rear zone” are confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

In claim 23 the phrase “said rib” lacks antecedent basis rendering the claim vague and indefinite. Claim 23 in its entirety is confusing, vague, and indefinite.

In claim 24 the phrase “said comfort zone” lacks antecedent basis rendering the claim vague and indefinite. Also, the phrase “clear it by a value equal to the thickness of said comfort layer to be produced” is confusing, vague, and indefinite.

In claim 25 the phrase “allows mechanical attachment...” and in claims 26 and 27 the phrase “can allow mechanical attachment...” are functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. It is not clear what structural limitations applicant intends to encompass with such language.

In claim 25 the phrase “comprising or not...said insert and/or said loop” are confusing, alternative, vague, and indefinite.

In claim 29 the phrase "providing both for the distribution of shockwaves and stresses sensed by said ground contact layer and for their diffusion over said comfort layer" is functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. The recitation that "the intermediate layer extends over at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel" is insufficient for the above recited function.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 28 and 29 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Tong (5185943).

Tong shows a shoe comprising a laminated profile sole comprising a ground contacting layer (26 or 118), an upper comfort layer (28 or 116), and an intermediate layer (56 or 120) as claimed. In reference to claim 29, the intermediate layer is clearly located as claimed, i.e. "extending over at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe" and therefore if such recitation is sufficient (as applicant argues) for the recited claimed function "providing both for the distribution of shockwaves and stresses sensed by said ground contact layer and for their diffusion over said comfort layer" then the structures shown by Tong are inherently capable of such performing said function.

8. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by Barry (5052130).

Barry shows a shoe comprising a laminated sole comprising a ground contacting layer (16), a comfort layer (18), and an intermediate layer (20) which covers "substantially" an entire area of the ground contacting layer as claimed.

9. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Misevich (4854057).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread/gripping portion 32 and cushioning/flexible portion 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) which covers "at least a surface of said ground contact layer which is directly beneath a lateral portion of a heel of a person wearing the sport shoe" as claimed. Misevich clearly states in column 7 line 17- line 20 "the stiffer plate 37 is made, the more evenly

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the wearer's heel load will be distributed over the underlying midsole layer 46 to more uniformly compress layer 46."

10. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Giese (5025573).

Giese shows a shoe comprising a laminated sole comprising a ground contacting layer (elements shown in figures 122-126 below element 31), a comfort layer (elements above element 31), an intermediate layer (31) "extending over substantially an entire surface of said ground contact layer" and which comprises in the metatarsal area, a succession of rigid inserts (31A) as claimed.

11. Claims 1, 2, 14-16, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukuoka (4079526).

Fukuoka shows a sole comprising an intermediate layer (25), a ground contacting layer (35), and a cushion layer formed by points (29, 33, and 31) inasmuch as the claims and specification are understood.

12. Claims 1, 19, 20, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Salzman (4186500).

Salzman shows a sole comprising a ground contacting layer (11) which is molded and forms arc shaped stops at the toe and heel portions in "recesses" of an intermediate layer (30) which covers "the entire" ground contacting surface, and a comfort layer (50) inasmuch as the claims are understood.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 17, 18, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of Giese (5025573).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering substantially the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines 37-46). Giese teaches extending a rigid intermediate layer

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(31) into the metatarsal area and forming the metatarsal area as a succession of rigid inserts (31A). It would have been obvious to extend the intermediate layer into the metatarsal area and to form such as a succession of rigid inserts as taught by Giese in the sole of Misevich to increase support into the metatarsal area without reducing the flexibility of the metatarsal area.

15. Claims 1, 2, 4-14, 21-23, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of either Hannibal (4651445) or Kurrash (4580359).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accommodate different running styles, let and foot asymmetries and body weights" (column 10 lines

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37-46). Either Hannibal or Kurrash teaches extending a substantially rigid support layer (30 or 36) to cover the entire surface of a ground contacting layer. It would have been obvious to extend the intermediate support layer to cover the entire surface of the ground contacting layer as taught by either Hannibal or Kurrash in the shoe sole of Misevich to increase the geometrical extent/area covered by the stiffening formation as suggested by Misevich to increase the support/stiffness in the forefoot area of the shoe.

In reference to claims 5-10, Misevich as modified above discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the materials claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4-14, 21-23, and 25-29 above, and further in view of Banich.

Misevich as modified above shows a shoe sole substantially as claimed except for the comfort layer having different areas of elasticity. Banich teaches providing a midsole (figure 4) having zones of different material properties. It would have been obvious to provide the comfort layer with zones as taught by Banich in the shoe sole of Misevich as modified above to improve stability and natural biomechanics of the foot.

Response to Arguments

17. Applicant's arguments filed 3/12/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the Recapture, these arguments are not persuasive because they do not take into account *Pannu v. Storz* 59 USPQ 2d 1597 which states "On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections". Applicant has attempted to recapture subject matter because the claims added in the reissue have deleted limitations which were added and argued to overcome the rejections, and therefore applicant surrendered subject matter which is broader than this limitation. It is noted that applicant did present claim language in original application (claim 25) which stated "sole according to claim 1, therein each of said layers constituting the sole extends or does not extend over its entire surface". Applicant canceled this claim in an amendment dated 2/7/94. The limitation of an intermediate layer which extends over less than the entire surface was presented and this limitation was canceled and a narrower limitation was presented and argued to overcome the prior art.

In reference to claim 29, it is noted that the realm of corrections in reissue applications does not include recapturing of surrendered subject matter "in an attempt to custom fit' the reissue claims to a competitor's product" (*Pannu v. Storz instruments Inc.* 106 F Supp. 2d 1304 at 1309 (July 10, 2000))

In response to applicants' arguments directed towards *Pannu v. Storz instruments Inc.*, the court did not engage in an analysis of the canceled or amended claims in the application that matured into the original patent for which reissue patent had been granted. The court merely noted that reissue claim 1 was broader than claim 1 of the original patent, that claim 1 in the original patent had contained limitations added to secure allowance, and that the reissue patent omitted a limitation added to secure allowance of the patent. The court dismissed the patentee's argument that the recapture rule was avoided by reason of certain limitations added in the claims as-reissued that were narrower than the originally patent claim because the narrower limitations were not related to the "surrendered subject matter," and then the court went on to state that; "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." The court further stated that; "in prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a 'continuous, substantially, circular arc.' On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections." The court appears to have considered that which was "surrendered" was the right to a claim that was broader than the specific limitation added to secure allowance. Absent any contrary evidence, an applicant who adds such a limitation for the purpose of securing allowance is considered to have abandoned the right to claims in which that limitation has been broadened or discarded.

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Another case of interest is *In Re Byers* (43 CCPA 803; 109 USPQ 53 (CCPA 1956)) the court specifically addressed the issue of the patentability of reissue claims of "intermediate scope", that is, reissue claims with a limitations broader than that added to secure allowance, yet narrower than certain canceled claims in the application which had been canceled to secure allowance of the original patent. The court wrote: "It is stated in the appellant's brief that claims 2 and 3 of the present appeal are intermediate in scope between certain broad claims which were canceled from appellant's original application and the limited claim allowed in the patent. Assuming that to be the case, it would not entitle appellant to the reissue sought here. The rejection is not based on the cancellation of the broader claims referred to in appellant's brief but on the limiting amendment which was of such a nature as to bar the allowance in a reissue application of the claims here on appeal. The fact that there were other claims whose cancellation did not constitute such a bar is immaterial."

The above cited cases appear to indicate that in certain decisions which defined "surrendered subject matter" in terms of claims that were canceled in favor of more limited claims or amended to include narrower limitations in order to secure allowance, "surrendered subject matter" in fact means the specific limitation which the record shows was added and/or argued to secure allowance. Absent any contrary evidence, an applicant who adds such a limitation for the purpose of securing allowance is considered to have abandoned the right to claims in which that limitation has been broadened or discarded. After the application matures into a patent, the patentee is estopped from obtaining broadened reissue claims that do not contain that precise

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limitation. While 35 USC 251 permits broadening of claim by way of reissue, not every error is correctible by reissue. The reason for the broadening must be to correct an error without deceptive intent, or the equivalent error through accident, inadvertence or mistake. Merely taking the view that an applicant seeking reissue committed an error in judgment by presenting and arguing a limitation more narrow than was needed in order to secure allowance is not acceptable as being the sort of error for which reissue is available. Note *Riley v. Broadway-Hale Stores* 217 F.2d 530; 103 USPQ 414 (9th Cir., 1954) and *In re Weiler*, 790 F.2d 1576, 229 USPQ 873 (Fed. Cir. 1986). Each of the above cases are examples of decisions in which the courts clearly indicated that the issue involved in what we today call "recapture" cases is more or less one of an attempt on the part of the patentee to "take back" a claim limitation that was added by the patentee to secure allowance of the original patent.

In response to applicants' arguments directed towards the rejections under 35 USC 112 first paragraph, there is no disclosure of (and therefore is not enabling) for an intermediate layer on the lateral heel area to provide the functions recited. In order for the intermediate layer to function as claimed, it would have to cover a substantially portion of the ground contacting layer. There is no disclosure contrary to such.

In response to applicants' arguments directed towards the rejections under 35 USC 112 second paragraph, the limitations of the intermediate layer being located on the lateral heel area is insufficient to support the function of the intermediate layer as claimed. There is insufficient structure recited to support the recited function and

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therefore it is not clear what structural limitations applicant intends to encompass with such language.

In response to applicants' arguments directed towards Tong, Tong clearly shows an intermediate layer which extends into the forefoot area (see figures 16 and 17) and since Tong and/or Barry shows all of the positively recited structures, it is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971). Also, it is noted that claim 29 merely requires that the intermediate layer be located at the lateral heel portion and since applicant considers this claim to recite sufficient structure for the recited functions in the claim, any of the intermediate layers disclosed by Tong are considered to meet the functional limitations claimed inasmuch as the claimed structures perform these functions. The intermediate layers of either Tong or Barry are considered to have controlled torsional and flecnional rigidity to some degree.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's

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convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728